

REMARKS**Summary of the Office Action**

Claims 3, 4, 9 and 10 stand rejected under 35 U.S.C. §101 because the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility.

Claims 3, 4, 9 and 10 stand rejected under 35 U.S.C. §112, first paragraph, because the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility for the reasons stated above.

Claims 1-4 stand rejected under 35 U.S.C. §103(a) as being unpatentable over 5C Digital Transmission Content Protection White Paper (hereinafter “*DTCP*”) in view of U.S. Patent No. 6,678,236 to *Ueki*.

Claims 5-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ueki*.

Summary of the Response to the Office Action

Applicant proposes canceling claims 3, 4, 9, and 10 without prejudice or disclaimer and adding claims 11-22. Accordingly, claims 1-2, 5-8, and 11-22 are pending for further consideration.

The Rejections Under 35 U.S.C. § 101 and 35 U.S.C. § 112, First Paragraph

Claims 3, 4, 9, and 10 stand rejected under 35 U.S.C. § 101 and under 35 U.S.C. § 112, first paragraph, as being not supported in the specification. Applicant respectfully submits that the rejections of claims 3, 4, 9, and 10 are moot in light of their cancellation.

The Rejection Under 35 U.S.C. § 103(a)

Claims 1-4 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *DTCP* in view of *Ueki*. Applicant respectfully traverses the rejection for at least the following reasons.

Applicant respectfully submits that independent claims 1 and 2 include at least “a copy protection information which is written in advance as a surface shape such as slits or corrugations in a region over a substrate of said data storing disk other than a data storage region. At least these features are absent from, and are neither taught nor suggested, alone or in combination, by either *DTCP* or *Ueki*.

To establish a *prima facie* case of obviousness, three basic criteria must be met (see MPEP §§ 2142-2143). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all the claim limitations.

First, The Office Action fails to provide any motivation in the references to modify the industrial decryption standard in *DTCP* with the contents scramble system key taught by *Ueki* to arrive at the present invention. The mere fact that references can be modified does not render the resultant combination obvious. *See* MPEP § 2143.01.

Second, as previously admitted, *DTCP* does not disclose a pickup unit for reading copy protection information. *Ueki* also does not teach or suggest a pickup unit, or a surface shape including slits or corrugations. As such, the suggestion or motivation to combine is not provided by either the references themselves or by knowledge generally available to one of ordinary skill in the art. Therefore, it is respectfully submitted that the statement in the Office Action is not sufficient by itself to meet the second prong of *prima facie* obviousness. In fact, the MPEP § 2143.01 states that “the level of skill in the art cannot be relied upon to provide the suggestion to

combine references.” *Al-Site Corp. v. VSI Int’l, Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d 1161 (Fed. Cir. 1999).

Third, the Office Action has not established a *prima facie* case of obviousness at least because neither *DTCP* nor *Ueki*, whether alone or in combination, teaches or suggests all the recited features of independent claims 1 and 2. Namely, neither *DTCP* nor *Ueki* teaches or suggests at least the step of “a pickup unit for reading a copy protection information which is written in advance as a surface shape such as slits or corrugations in a region over a substrate of said data storing disk other than a data storage region,” as recited in claims 1 and 2. As pointed out in M.P.E.P. § 2143.03, “[t]o establish prima facie obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art”. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). As such, Applicant respectfully asserts that the third prong of *prima facie* obviousness has not been met. Therefore, Applicant respectfully requests that the rejection under 35 U.S.C. § 103(a) should be withdrawn because *DTCP* and *Ueki* do not teach or suggest each and every feature of independent claims 1 and 2.

Claims 5-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ueki*. Applicant respectfully traverses the rejection for at least the following reasons.

Applicant respectfully submits that independent claims 5-8 include at least “a magnetic head for reading a program which is magnetically recorded in advance in the region over a substrate of a data storing disk other than a data storage region,” as recited in e.g., claim 5. At least these features are absent from, and are neither taught nor suggested, alone or in combination, by either *DTCP* or *Ueki*.

Neither *DTCP* nor *Ueki* teaches or suggests “a magnetic head for reading a program.”

Both the *DTCP* and *Ueki* references are directed to DVD technology without any mention of magnetic heads for reading programs. As such, the suggestion or motivation to combine is not provided by either the references themselves or by knowledge generally available to one of ordinary skill in the art. Therefore, it is respectfully submitted that the statement in the Office Action is not sufficient by itself to meet the second prong of *prima facie* obviousness. In fact, the MPEP § 2143.01 states that “the level of skill in the art cannot be relied upon to provide the suggestion to combine references.” *Al-Site Corp. v. VSI Int’l, Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d 1161 (Fed. Cir. 1999).

Finally, the Office Action has not established a *prima facie* case of obviousness at least because neither *DTCP* nor *Ueki*, whether alone or in combination, teaches or suggests all the recited features of independent claims 5-8. Namely, neither *DTCP* nor *Ueki* teaches or suggests at least the step of “a magnetic head for reading a program which is magnetically recorded in advance in the region over a substrate of a data storing disk other than a data storage region,” as recited in claims 5-8.

As pointed out in M.P.E.P. § 2143.03, “[t]o establish prima facie obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art”. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). As such, Applicant respectfully asserts that the third prong of *prima facie* obviousness has not been met. Therefore, Applicant respectfully requests that the rejection under 35 U.S.C. § 103(a) should be withdrawn because *DTCP* and *Ueki* do not teach or suggest each and every feature of independent claims 5-8.

CONCLUSION

In view of the foregoing, Applicant respectfully requests reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the response, the Examiner is invited to contact the Applicant's undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. §1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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